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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,982	07/17/2003	Stephan Gropp	GRAT 20.504	2157

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EXAMINER

HAN, JASON

ART UNIT PAPER NUMBER

2875

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

(2)

<b>Office Action Summary</b>	<b>Application No.</b> 10/621,982	<b>Applicant(s)</b> GROPP ET AL.	
	<b>Examiner</b> Jason M Han	<b>Art Unit</b> 2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. <u>1/13/2005</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                                     |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/17&amp;10/23 of 2003</u> . | 6) <input type="checkbox"/> Other: _____.   |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed January 21, 2005 have been fully considered but they are not persuasive.

As broadly interpreted [MPEP 2111], all structural limitations of independent Claim 1 have been taught or suggested by the prior art. Applicant's primary dispute was that the primary reference of Skoff does not specifically teach a headlight unit whereby the illumination of left-hand curves and right-hand curves are operated by the right and left cornering headlights respectively, and wherein said cornering headlights are turned downward around their optical axis ("cross-over" concept). The embodiment described by Skoff is the vice versa and a variant of said configuration, whereby applicant believes that the "cross-over" modification would not have been obvious to one skilled in the art.

First, in lines 7-8 of the claim the applicant recites, "for illumination in left-hand curves and for illumination in right-hand curves respectively". However, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Second, Skoff discloses the claimed invention as cited above except for the left and right headlights pointing in a "cross-over". It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the headlamps in "cross-over", since it has been held that rearranging parts of an invention

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involves only routine skill in the art. *In re Japiske*, 86 USPQ 70. In addition, Skoff corroborates such a rearrangement, "provided the central direction of the beam of each cornering lamp is maintained at the proper angle, the lamps may be affixed to the vehicle in any position consistent with applicable law [Column 7, Lines 14-17]."

All subsequent dependent Claims 2-16 stand rejected under the previous Office Action filed August 10, 2004.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 6-9, 10, and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skoff.

With regards to Claim 1, Skoff discloses a cornering light system for a two-wheeled vehicle that experiences an inclination due to the negotiation of curves when driving. The system comprises of a sensor-controlled correction device for illumination of a curve [Claims 5-8; Figure 10], a central headlight for straight-ahead driving [Figures 2-5], and lateral headlights mounted to the right and left of said central headlight and rotated about their optical axis to compensate for said inclination [Claim 2; Figures 2-5 (11,13); Figures 11-12; Column 5, Lines 53-68; Column 10, Lines 1-11]. Skoff further discloses that said correction device operates such that the central headlight is on during substantially upright driving and, during negotiation of curves, turns on at least

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either the left or right headlight upon passage through a minimum roll angle [Claim 1; Column 7, Lines 33-39; Column 9, Lines 64-68].

Skoff does not specifically disclose an embodiment of said headlight unit whereby the illumination of left-hand curves and right-hand curves are operated by the right and left cornering headlights respectively, and wherein said cornering headlights are turned downward around their optical axis. The embodiment described by Skoff is just the vice versa and a variant of said configuration, and would be obvious to those skilled in the art that both embodiments perform the same function. Skoff also teaches that "provided the central direction of the beam of each cornering lamp is maintained at the proper angle, the lamps may be affixed to the vehicle in any position consistent with applicable law [Column 7, Lines 14-17]." Therefore, said embodiments are dependent upon the appeal to motorcyclists who would prefer their corner lamps pointing either inwardly or outwardly. To further elucidate, it would be obvious to modify Skoff to include a multiple of options with regard to headlamp configurations, specifically one whereby the cornering lamps are pointing inwardly toward the central headlight.

3. With regard to Claims 2 and 3, Skoff teaches that the headlight illumination of the three lamps may be configured in a number of combinations by dimming or dipping means, thereby allowing for one of the cornering lights to be turned on during negotiation of a curve, while the other two headlights are turned off [Column 3, Lines 20-36]. Skoff also mentions that, given the plethora of actuating/manual switches, a specific setup may be attained whereby the lateral headlights are turned on or off before

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the central headlight is turned off or on respectively [Column 8, Line 5 – Column 9, Line 68].

4. With regards to Claim 4, Skoff discloses “one unique feature of the system is the use of a beam whose centerline and cross section are chosen to permit maximum illumination of the selected areas on the ground when the vehicle is rounding a corner at a tilted altitude [Column 9, Lines 60-64].” In addition to Paragraph 3 above, a configuration may be provided wherein the central headlight is turned on while driving substantially upright and, during the negotiation of curves, turns either the left or right cornering lamp with full illumination power upon passage through a minimum roll angle, while the respective other two headlights remain turned on with relatively low, non-blinding power.

5. With regards to Claim 6, Skoff discloses that the cornering headlights may be laterally adjoining the central headlight and mounted lower than the middle headlight relative to the upright orientation of the vehicle [Column 7, Lines 14-32].

6. With regard to Claims 7 and 10, Skoff discloses said cornering lamps skewed at an angle pointing upward and away from the vehicle [Figures 2-5; Column 6, Lines 11-16]. As explained in Paragraph 2 above (the differing embodiments are functionally equivalent), such lamps may be rearranged so as to meet the criteria of this limitation, whereby said cornering lamps are skewed toward the middle headlight. Skoff also mentions that said skewed angles are empirically determined according to precise parameters, and are subject to accommodate for variations in embodiment [Column 6, Lines 1-23].

7. With regard to Claims 8 and 15, Skoff teaches, "it has been found advantageous to arrange for the centerline of the beam of each lamp to be positioned so that the projection of the centerline onto the horizontal plane makes an angle of approximately 28°." Skoff discloses that the angle of the optical axis with respect to the horizontal plane is subject to accommodate for variations in embodiment [Column 6, Lines 1-23]. To further note, 'approximately 28°' would appear to meet the limitation of an angle at 30°.

8. With regard to Claims 9 and 16, Skoff provides multiple configurations regarding illumination at various roll angles between 10° and 45° [Column 7, Line 33 – Column 8, Line 4].

9. With regards to Claim 14, Skoff discloses a stabilization device wherein two sensors are used for measuring the negotiation of a curve [Column 8, Lines 55-59].

10. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Skoff as applied to Claim 1 above, and further in view of Ulrich.

With regards to Claim 5, Skoff teaches a cornering light system, but does not disclose such a system wherein a safety circuit turns on the lateral headlights due to a central headlight failure, and vice versa.

On the other hand, Ulrich teaches an electronic control means and method for controlling lights wherein an emergency switch [Figure 1] may be used for said purpose of the safety circuit described. It would have been obvious to modify Skoff with more options and controls for the cornering light system, such as those taught by Ulrich, in

order to give more power and appeal to motorcycle enthusiasts. Please further note U.S. Patent 5477208.

11. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skoff as applied to Claim 1 above, and in further view of Sumada et al.

12. With regards to Claims 11-13, Skoff teaches a cornering light system, but does not disclose such a system in a common headlight housing, wherein the sensor and control unit are installed in or are connected thereto, wherein each of the lamps are equipped with multiple reflectors, and whereby a front lens is provided with dispersion sections. It would have been obvious to modify Skoff to incorporate the above limitations, such as taught by Sumada [Figure 11; Column 5, Line 63 – Column 6, Line 14; see also CLAIMS], in order to produce a simple, low-cost, efficient, and effective illumination system. Please further note U.S. Patent 6390656.

13. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Skoff (U.S. Patent 4024388) in view of Stelling et al. (U.S. Patent 5727864).

Skoff discloses a cornering light system for two-wheeled vehicles including:

- a plurality of headlights [Figures 2-5: (11, 13)];
- a left lateral headlight [Figures 2-5: (13)], a right lateral headlight [Figures 2-5: (11)], and a central headlight [Figures 2-5] disposed there between;
- whereby a sensor-controlled correction device [Claims 5-8] further includes an electronic control unit [Figure 10] that turns on the central headlight when the vehicle progresses substantially upright and, during negotiation of curves, turns on at least either the left or right headlight upon passage through a



minimum roll angle [Claim 1; Column 7, Lines 33-39; Column 9, Lines 64-68]  
via rotation about an optical axis of said left or right headlight to compensate  
for the inclination [Claim 2; Figures 2-5, 11-12; Column 5, Lines 53-68;  
Column 10, Lines 1-11].

Skoff does not specifically teach an embodiment of the headlight unit whereby  
the illumination of left-hand curves and right-hand curves are operated by the right and  
left cornering headlights respectively, such that when negotiating a right-hand curve the  
left lateral headlight is disposed to be the highest of the plurality of headlights, and vice  
versa. The embodiment described by Skoff is just the opposite and a variant of said  
configuration, and would be obvious to those skilled in the art that both embodiments  
perform the same function. Skoff corroborates rearrangement of the cornering lamps,  
“provided the central direction of the beam of each cornering lamp is maintained at the  
proper angle, the lamps may be affixed to the vehicle in any position consistent with  
applicable law [Column 7, Lines 14-17].”

In addition, Stelling teaches a light support assembly wherein left and right  
sidelights [Figure 1: (16)] are disposed such that when negotiating a right-hand curve  
the left sidelight is disposed to be the highest of the plurality of headlights, and vice  
versa. Stelling further teaches that said sidelights may be adjusted/tilted toward side-to-  
side directions [Column 3, Lines 47-51], such that during negotiation of right-hand  
curves the left sidelight may be disposed to point downward toward the traveling  
surface, and vice versa.

It would have been obvious to modify the headlight unit of Skoff to incorporate the light support assembly of Stelling in order to provide greater flexibility and control of the cornering lamps, as well as appeal to motorcyclists who would prefer their corner lamps to point either inwardly or outwardly. Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to dispose the cornering lamps at a higher spot on the motorcycle, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japiske*, 86 USPQ 70.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following references are cited to further show the state of the art pertinent to the current application, but are not considered exhaustive:

US Patent 5477208 to Henderson et al;


US Patent 6390656 to Suda et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M Han whose telephone number is (571) 272-2207. The examiner can normally be reached on 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JMH (1/31/2005)



**JOHN ANTHONY WARD**  
**PRIMARY EXAMINER**